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21 AUG 2007

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In re Application of	:	
ROTHENBERG, et al.	:	
Application No.: 10/534,303	:	DECISION ON PETITIONS
PCT No.: PCT/US03/35690	:	
Int. Filing Date: 07 November 2003	:	UNDER 37 CFR 1.183 AND
Priority Date: 08 November 2002	:	
Atty. Docket No.: 15804	:	37 CFR 1.497(d)
For: ASSAY FOR AUTOANTIBODIES TO FOLATE RECEPTORS	:	

This decision is in response to applicant's "PETITION UNDER 37 C.F.R. §1.183" filed 15 May 2007 in the United States Patent and Trademark Office (USPTO). Applicant has provided payment of the $400.00 petition fee.

BACKGROUND

On 07 November 2003, applicant filed international application PCT/US03/35690 which claimed priority to an earlier U.S. application filed 08 November 2002. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States was set to expire at midnight on 08 May 2005.

On 09 May 2005, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a First preliminary amendment.

On 29 August 2005, applicant was mailed a "Notification of Missing Requirements" (Form PCT/DO/EO/905) informing applicant that an executed oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required. Applicant was afforded two months to file the required response and advised that this period could be extended pursuant to 37 CFR 1.136(a).

On 01 November 2005, applicant filed an execute combined declaration and power of attorney.

On 06 March 2006, applicant was mailed a "Notice of Acceptance of Application Under35 U.S.C. 371 and 37 CFR 1.495" (Form PCT/DO/EO/903).

On 15 May 2007, applicant filed the petition under 37 CFR1.183 considered herein.

DISCUSSION

I. PETITION UNDER 37 CFR 1.183

Applicant's petition under 37 CFR 1.183 arises out of applicant's concurrently filed petition under 37 CFR 1.48(a) to add a fourth inventor, Mr. Edward V. Quadros, to the application. Specifically, applicant is contending that one of the three original inventors, Maria da Costa, has refused to execute a declaration which lists Mr. Quadros as one of the inventors. Applicant seeks suspension of the rule and waiver of the signature requirement of Ms. Da Costa.

The Manual of Patent Examining Procedure (MPEP) section 201.03 II A details the procedures for the present scenario:

> Alternatively, where D is to be added as an inventor (where inventors A, B, and C have previously executed the application under 37 CFR 1.63) and it is original inventor A who refuses to cooperate, the statement under 37 CFR 1.48(a)(2) is only required to be signed by inventor D. Originally named inventor A is merely required to reexecute an oath or declaration in compliance with 37 CFR 1.63. Petitions under 37 CFR 1.47 are only applicable to an original oath or declaration and are not applicable to the reexecution of another oath or declaration by A. In such circumstances, a petition under 37 CFR 1.183 should be considered requesting waiver of the requirement of 37 CFR 1.64 that each of the actual inventors, i.e., inventor A, execute the oath or declaration, particularly where assignee consent is given to the requested correction. Absent assignee consent, the petition under 37 CFR 1.183 requesting waiver of the reexecution of the oath or declaration will be evaluated as to whether the nonsigning inventor was actually given the opportunity to reexecute the oath or declaration, or whether the nonsigning inventor could not be reached.

Applicant has presently provided a petition under 37 CFR 1.183 requesting waiver of the signature requirement of inventor Da Costa. It is clear from the filed papers that Ms. Da Costa was provided with the opportunity to reexecute the oath or declaration and refused. As such, it is proper to grant applicant's petition under 37 CFR 1.183 at this time.

II. PETITION UNDER 37 CFR1.497(d)

37 CFR 1.497(d) [formally, 37 CFR 1.48] states in part: "If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application....applicant must submit:

(1) a statement from each person being added or deleted as an inventor that the error in inventorship occurred without any deceptive intention on his or her part;

(2) the fee set forth in 37 CFR 1.17(h); and

(3) if an assignment has been executed by any of the original named inventors, the written consent of the assignee in compliance with 37 CFR 3.73(b); and

(4) any new oath or declaration required by paragraph (f) of this section.

Applicant has satisfied items (1), (2) and (4) (as discussed above). Item (3) does not apply. As such, it is proper to grant applicant's petition at this time.

CONCLUSION

Applicant's petition under 37 CFR 1.183 is **GRANTED**.

Applicant's petition under 37 CFR 1.497(d) is **GRANTED**.

This application is being forwarded to Group Art Unit 1647 for examination.

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APPL NO.	FILING OR 371(c) DATE	ART UNIT	FIL FEE REC'D	ATTY.DOCKET NO	TOT CLMS	IND CLMS
10/534,303	11/01/2005	1647	1120	15804	24	4

CONFIRMATION NO. 9810

CORRECTED FILING RECEIPT

OC000000025483664

272
SCULLY, SCOTT, MURPHY & PRESSER, P.C.
400 GARDEN CITY PLAZA
SUITE 300
GARDEN CITY, NY 11530

Date Mailed: 08/21/2007

Receipt is acknowledged of this nonprovisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Filing Receipt Corrections. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).**

Applicant(s)

Sheldon P Rothenberg, New York, NY;
Maria Da Costa, New York, NY;
Jeffrey Sequeria, Brooklyn, NY;
Edward V. Quadros, Brooklyn, NY;

Power of Attorney: The patent practitioners associated with Customer Number **272**.

Domestic Priority data as claimed by applicant

This application is a 371 of PCT/US03/35690 11/07/2003

Foreign Applications

UNITED STATES OF AMERICA 60424965 11/08/2002

If Required, Foreign Filing License Granted: 09/12/2006

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is US10/534,303

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No

**** SMALL ENTITY ****

Title

Assay for autoantibodies to folate receptors

Preliminary Class

435

PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at http://www.uspto.gov/web/offices/pac/doc/general/index.html.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, http://www.stopfakes.gov. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

LICENSE FOR FOREIGN FILING UNDER
Title 35, United States Code, Section 184
Title 37, Code of Federal Regulations, 5.11 & 5.15

GRANTED

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license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

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The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

NOT GRANTED

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